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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,219	11/12/2003	Bindu Rama Rao	14321US03	6320
23446 7590 05/02/2007 MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER KENDALL, CHUCK O	
			ART UNIT 2192	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/706,219	RAO, BINDU RAMA	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chuck O. Kendall	2192	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This action is in response to application filed 02/14/07.
2. Claims 1 - 23 were previously presented. Claims 24 – 29 have been added and have also been considered

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 - 3, 5 -17, and 20 – 25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Johansson et al. (US Patent 5,418,837).

**Claim 1:**

Johansson discloses an updatable electronic device including:

a memory including at least one of firmware and software (e.g. see Fig. 1A, items 15, and associated text);

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at least one firmware component, functioning to update at least a portion of at least one of firmware and software ("the routine then changes all the software in the mobile terminal...", col. 7, lines 13 – 16, Fig. 3);

an interface for communicatively coupling to a removable electronic memory device (e.g. see Fig. 1A, item 20, and associated text);

and the removable electronic memory device including information related to the updating of the at least a portion of the at least one of firmware and software (Fig. 1A, item 22, and associated text).

**Claim 2:**

Johansson discloses the device of claim 1 where the at least one firmware component comprises: an update agent for updating the at least a portion of the at least one of firmware and software, the update agent using at least one of an update package and the information related to the updating of the at least one of firmware and software ("the routine then changes all the software in the mobile terminal from information provided in the upgrading software stored in the SUM card", col. 7, lines 13-16, Fig. 3, and associated text);

**Claim 3:**

Johansson discloses the device of claim 2 further including: a communication interface for receiving the update package (Fig. 1A, item 20, and associated text).

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Claim 5:

Johansson discloses the device of claim 2 where the update package comprises a set of instructions for updating the at least a portion of the at least one firmware and software ("upgrading data" may be stored in the SUM card, col. 4, lines 7-14, e.g. see Fig. 213, and associated text).

Claim 6:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises at least one of a cyclic redundancy check (CRC), a location in a file system, a memory address, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6, e.g. see Fig. 3, step 110, and associated text).

Claim 7:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises an indication of the availability of an update for the at least one of a firmware and software (e.g. see Fig. 3, and associated text, col. 7, lines 6-7 states "if the SUM card is valid for upgrading, the upgrading functions would be displayed on the display...").

Claim 8:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software comprises an indication of the success of an update of the at least one of firmware and software (Fig. 3, item 120).

Claim 9:

Johansson discloses the device of claim 1 where the information related to the updating of the at least one firmware and software is used to verify or authenticate an update of the at least one of firmware and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35-39).

Claim 10:

Johansson discloses the device of claim 1 where the removable electronic memory device comprises one of a subscriber identity module (SIM) card, a smart card, an integrated circuit (IC) card, a removable memory card, and a removable memory module (Fig. 1A, item 22).

Claim 11:

Johansson discloses a method of updating an updatable electronic device including a memory containing at least one of firmware and software, and a user removable electronic memory device (Abstract), the method including:

retrieving information from the user removable electronic memory device  
("upgrading functions would be displayed", col,7, lines 7- 8);

determining whether an update of the at least one of firmware and  
software is available using information from the user removable electronic  
memory device ("if the SUM card is valid for upgrading", col. 7, lines 7 - 8);

performing an update of at least a portion of the at least one of firmware  
and software using at least information from the user removable electronic  
memory device, if an update of the firmware is available ("new features are  
installed ", col. 7, lines 21-23)

and refraining from performing an update of at least a portion of the at  
least one of firmware and software, if an update of the firmware is not available  
("activates normal GSM network activities", col. 6, lines 47 – 48).

Claim 12:

Johansson discloses the method of claim 11 where the user removable  
electronic memory device comprises one of a subscriber identity module (SIM)  
card, a smart card, an integrated circuit card, a removable memory card, and a  
removable memory module (Fig. 1A, item 22).

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Claim 13:

Johansson discloses the method of claim 11 where the updatable electronic device is a mobile handset (Fig. 1A).

Claim 14:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device comprises at least one of a signature, a location in a file system, a memory address,, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col..4, line 3 – 6).

Claim 15:

Johansson discloses the method of claim 14 where the signature comprises a cyclic redundancy check (CRC) ("checksum or check data area", col. 4, line 8).

Claim 16:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device comprises an indication of the availability of an update for the at least a portion of the at least one of a firmware



and software ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6).

Claim 17:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device is used to verify or authenticate an update of the at least a portion of the at least one of a firmware and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35 - 39).

Claim 20:

Johansson discloses the method of claim 11 further including: storing status information in the user removable electronic memory device, if an update was performed; and refraining from storing status information in the user removable electronic memory device, if an update was not performed ("data area that can be altered during or after a complete upgrading procedure", col. 4, lines 9 -14).

Claim 21:

Johansson discloses the method of claim 11 further including: performing at least one of restarting or rebooting the updatable electronic device ("re sets the telephone", col. 6, lines 54-56).

Claim 22:

Johansson discloses the method of claim 21 where at least one of a need to restart or reboot and a type of reboot is resident in the user removable electronic memory device ("If the card installed is not valid ... re sets the telephone", col. 6, lines 52-56).

Claim 23:

Johansson discloses the method of claim 11 where the determining comprises:

verifying whether the retrieved information is at least one of appropriate and authentic ("check that correct data is transferred ... ", col. 5, lines 35 -39);

continuing the performance of an update, if the verification is successful;  
and

executing a normal startup of the updatable electronic device, if the verification is not successful ("activates normal GSM network activities", col. 6, lines 47-48).

Claim 24 and 27:

The updatable electronic device of claim 1, wherein the update information comprises at least one update package (2:35 – 40, see upgrade software).

Claim 25:

The updatable electronic device of claim 1, wherein the information related to the updating of the at least one of firmware and software comprises information identifying the source of the update information received by the electronic device (5:35 – 40).

### **Claim Rejections 35 USC § 903**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 4, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) in view of Ericsson (US Patent 6,556,842).

Claim 4:

Johansson discloses the device of claim 3 but he does not disclose where the communication interface is a wireless communication interface. In an analogous art of updating mobile phones, Ericsson discloses transmitting update information to a SIM card wirelessly (Abstract, Fig. 2, and associated text). It would have been obvious to one with ordinary skill in the art at the time of the invention to wirelessly update the device as claimed in order to ensure timely updates through the air and because returning the SIM card to the operator by post for updates is time consuming (Ericsson col.1, line 62 to col. 2, line 5).

Claims 18 -19:

Johansson discloses the method of claim 11 but he does not disclose receiving an update package from a server; and the receiving performed using a wireless network; and the information from the user removable electronic memory device comprises the location of at least one of the update package and the server.

In an analogous art of updating mobile phones, Ericsson discloses transmitting update information to a SIM card wirelessly (Abstract, Fig. 2, and

associated text), where the information from the user removable electronic memory device comprises the location of at least one of the update package and the server ("the information about each subscriber's allowed LSA... is stored in the SIM", col. 1, lines 24-26). It would have been obvious, to one with ordinary skill in the art at the time of the invention to wirelessly update the device as claimed in order to ensure timely updates through the air and because returning the SIM card to the operator by post for updates is time consuming (Ericsson col.1, line 62 to col.2, line 5).

7. Claims 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) as applied in claims 11 and 25 and in view of Rasmussen USPN 6,640,334 B1.

Regarding claim Claims 26 Johansson discloses all the claimed limitations as applied in claims 25 above. Johansson doesn't expressly disclose the updatable electronic device of claim 25, wherein the information identifying the source of the update information comprises a universal resource locator (URL). However, Rasmussen in an analogous art and similar configuration of updating firmware of a communication device (see abstract and title) discloses that, "Downloading updated software (e.g. through the Internet) is commonly used as a means of distributing software updates" (3:2 – 25) and it is recognized in the art to use URL for downloading through internet protocol in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Johansson and Rasmussen because, it's a common practice for distributing software updates.

Regarding claim 28, Johansson discloses all the claimed limitations as applied in claim 11 above. Johansson doesn't expressly disclose determining comprises, downloading the update information from a remote server identified in the user removable electronic memory device.

However, Rasmussen in an analogous art and similar configuration of updating firmware of a communication device (see abstract and title) discloses being able to, "permit the firmware 20 to be updated under the control of either the host computer 12 or through the network 4 by an update server 16 at the manufacturer's site" (7:60 – 67). Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Johansson and Rasmussen because, it would enable being able to control the updating for the remote location.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) in view of Ericsson (US Patent 6,556,842) as applied in claim 19 and further in view of Rasmussen USPN 6,640,334 B1.

Regarding claim Claims 29 Johansson as modified by Ericsson discloses all the claimed limitations as applied in claims 25 above. The combination of Johansson and Ericsson doesn't expressly disclose the updatable electronic device of claim 25, wherein the information identifying the source of the update information comprises a universal resource locator (URL). However, Rasmussen in an analogous art and similar configuration of updating firmware of a communication device (see abstract and title) discloses that, "Downloading updated software (e.g. through the Internet) is commonly used as a means of distributing software updates" (3:2 – 25) and it is recognized in the art to use URL for downloading through internet protocol in the art.

Therefore it would have been obvious to one of ordinary skill in the art at the time invention was made to combine Johansson and Ericsson with Rasmussen because, it's a common practice for distributing software updates.

Applicant relies on an assertion of an improper 35 USC 102 rejection to assert an improper motivation argument under '103. However since the '102 rejection is proper as addressed above the 103 rejection is also proper as well.

### ***Response to Arguments***

9. Applicant's arguments filed 02/14/07 have been fully considered but they are not persuasive.

Argument (1), Applicant argues on page 8 of his response that in claims 1 and 11, that Johansson fails to teach "update information stored in the memory" as well as determining whether update information for updating the at least one of firmware and software is available in the memory".

Response (1), Examiner believes that Johansson does in fact disclose this limitation. In 2: 35 – 40, Johansson discloses a module reader within the device which is communicatively coupled and which receives update information in the storage memory that is transmitted to the main memory of the mobile device. Applicant's plain language of claims merely discloses update information stored in the memory, and this is taught by Johansson. Also Module reader is to read the update information from the storage card, hence being able to determine if the update information is available is also taught as well.

### **Correspondence information**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory



action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-272-3698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ck.

Chuck Kendall 4/30/07